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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,692	11/16/1999	TETSURO MOTOYAMA	5244-0104-2X	3301
22850	7590	12/15/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ZIA, SYED	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/440,692

Applicant(s)

MOTOYAMA ET AL.

Examiner

Syed Zia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11-17,19-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-17,19-25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to response filed on June 24, 2004. Original application contained Claims 1-32. Applicant previously amended Claims 1, 9, 11-14, 17, 19-22, 25, and 27-30. Applicant previously cancelled Claims 2, 10, 18, and 26. Therefore, presently pending claims are 1, 3-9, 11-17, 19-25, and 27-32.

2. In view of the Appeal Brief filed on June 24, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Information Disclosure Statement***

3. The information disclosure statement filed on July 23, 2004 regarding copending application is placed in the application file, and the information referred to therein has been considered.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 3-9, 11-17, 19-25, and 27-32 have been considered but are moot in view of the new ground(s) of rejection.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1, 3-9, 11-17, 19-25, and 27-32 of instant Application No. 09/440692 (hereafter '692) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8-9, 12-15, 18-19, 21-24, 27-28, 30-33, and 36 of copending Application No. 09/440645 (hereafter '645).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in view of the obviousness type double patenting rationale as enunciated in **Georgia-**

Art Unit: 2131

**Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593**

(Fed. Cir. 1999, because the instant application claims system, method, and software product for monitoring a desired device by generating a log file automatically based on the already set control/alerts, and transferring/accessing log-file based on log-file data encoding/decoding is obvious variation of log-file data in the form of mapping where each of key data in a key portion of the map is mapped to respective value data in a corresponding value data portion; which are claimed in the claims 1, 3-6, 8-9, 12-15, 18-19, 21-24, 27-28, 30-33, and 36 of '645; therefore claims of instant application is a mere obvious variation of '645.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5-9, 13-17, 21-25, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frantz (U. S. Patent 6,003,070) and further in view of Reed et al. (U. S. Patent 6,008,717).

6. Regarding claims 1, and 17 Frantz teaches and describes a system (Fig1-3) of tracking device(s) activities that consist of monitoring, tracking, and writing device operational characteristics in a log file, comprising:

- a device comprising an interface [Fig.1 Item 10], the interface comprising a plurality of operations [activation criteria] to be selected by a user (col. 4 line 10 to line 30, and col.5 line 3-13);

- a monitoring device [Fig.2 Item 31] configured to monitor data of selecting of the plurality of operations of the interface by the user, and to encode and store the monitored data into a log-file [Fig.2 Item 32] in the device [Fig.2 Item 30] (col.6 line 1 to line 11);

- a communicating device [Fig.1 Item 16] configured to receive the log file of the monitored data, to decode the stored encoded log file, to create a message of the monitored data [Fig.1 Item 25, and 11], and to then communicate the message of the monitored data [Fig.1 Item 11, 21, and 12] (col.4 line 32 to line 42, col.5 line 28 to line 39, and col.6 line 12 to line 20);

- wherein the monitoring device includes a control [Alert mode] to automatically start the monitoring without an input from a device to which the message of the monitored data is to be communicated (col.5 line 32 to line 39, and col.5 line 3 to line 13); and

- wherein the communication device includes a control [Alert mode] to automatically communicate the message of the monitored data by a unidirectional communication without requiring input from the device to which the message of the monitored data is to be communicated (col.5 line 32 to line 39, and col.5 line 3 to line 13, and col.6 line 12 to line 20).

Although the system disclosed by Frantz shows all the features of the claimed limitation, but it does not specifically disclose the *encode/decode* of monitored data into a log-file.

In an analogous art, Reed, on the other hand, discloses computing environment for generating a parameterized [such as key/value pair] log file entries, and performing *translation, encryption or format conversion* as required based on, the monitored data value(s) of device [encoding], and stored values in the log file [decoding] when reading that log file (col.107 line 7 to line 56).

It would have been obvious to one skilled in the art at the time of invention was made to combine the teachings of Frantz and Reed, because Reed's method of encoding/decoding of monitored data by using parameterized and key/value pair would provide structure, security, and streamline the log entries [such as format changing] of Frantz's system for storing in database, and specially sorting and searching during analysis of monitored data.

7. Claims 9, and 25 are rejected for the same reason as to claims 1, and 17 above. In addition, means, and a program product including a computer readable medium embodying program instructions for causing a system to perform the claimed method steps, is inherent in the system of Frantz and Reed.

8. Claims 3-4, 11-12, 19-20, and 27-28 are rejected under 35 U.S.C.103 (a) as being unpatentable over Frantz (U. S. Patent 6,003,070) and further in view of Motoyama (U. S. Patent 5,819,110).

Art Unit: 2131

9. Claims 3-4, 11-12, 19-20, and 27-28 are rejected applied as above in rejecting Claims 1, 9, 17, and 25. Furthermore, the system disclosed by Frantz teaches a smart Internet interface for device status reporting and control, wherein

- the device is an image forming device [business machines such as photocopier, printer] and the interface is an operation panel of the image forming device; and the device is an appliance [home-type appliances] and the interface is an operation panel of the appliance (col.2 line 15 to line 31).

Frantz does not explicitly disclose an operational [electronic] panel (i.e. display) of device(s) where information received and controlled by the interface is displayed.

Motoyama teaches and describes a system and method of collecting operational data of business devices and transmitting those data to remote center. The business devices of this system also have enhanced electronic component, such as integral digital display attached to devices [copier/printers, appliances or business machines] (Fig.5 Item 174, 272, col.8 line 44 to 53).

Therefore, it would have been obvious to one skilled in the art at the time of invention was made to combine the teachings of Frantz and Motoyama, because Motoyama system of intelligent devices, such as business machines, or appliances with a digital panel to display the operational information of devices would make interface action of Frantz's system devices visible during operation and provide ability to select interface options manually when required.

9. Claims 5-8, 13-16, 21-24, and 29-32 are rejected applied as above in rejecting Claims 1, 9, 17, and 25. Furthermore, the system of Frantz, and Reed teaches and describes that

Art Unit: 2131

particularly relates to a client side status reporting, usage, control, monitoring and processing by recording device interaction with application interface software in a network environment, comprising:

- the communicating device sends the log of the monitored data when the user exits the device (Frantz: col.4 line 32 line 52);

- a setting unit [Fig.2 Item 25] configured to set a number of sessions of the device to be executed by the user prior to the communicating device communicating the log file of the monitored data (col. 4 line 56 to col.5line 12)

- the monitoring device [Frantz: Fig.2 Item 31] encodes the monitored data into the log file and the communicating device [Frantz: Fig.1 Item 16] decodes the monitored data from the log file by defining the encoding and decoding objects as abstract classes and defining derived classes to include encoding and decoding algorithms (Reed: col.107 line 7 to line 56).

- the communicating device communicates the log of the monitored data by Internet mail (Frantz: col.4 line 31 to line 36).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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December 02, 2004